

REMARKS

The Office Action dated January 12, 2005, has been received and carefully considered. In this response, claims 1, 3, 6, 8, 11, 17, 18, 22, and 31 have been amended. Entry of the amendments to claims 1, 3, 6, 8, 11, 17, 18, 22, and 31 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. THE INDEFINITENESS REJECTION OF CLAIM 22

On page 2 of the Office Action, claim 22 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is hereby respectfully traversed.

The Examiner asserts that there is insufficient basis for the term "the pedestal."

Claim 22 has been amended to address the Examiner's concern.

In view of the foregoing, it is respectfully requested that the aforementioned indefiniteness rejection of claim 22 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 1-17, 31, AND 33-36

On pages 2-9 of the Office Action, claims 1-17, 31, and 33-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bears (U.S. Patent No. 5,349,457). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Regarding claim 1, the Examiner asserts that the claimed invention would have been obvious in view of Bears. However, it is respectfully submitted that Bears fails to claim, disclose,

or even suggest dual optical switch fabric modules coupled to transmit signals to and receive signals from subscriber service modules and including a first switch fabric module and a second switch fabric module, as presently claimed. Indeed, Bears explicitly discloses an electrical based multiplexer/demultiplexer (e.g., 60) and electrical/optical converters (e.g., 54, 58) in the disclosed fiber service terminals (FST), thereby precluding the use of any optical switching means. Accordingly, it is respectfully submitted that Bears fails to claim, disclose, or even suggest the claimed invention, and thus the claimed invention is not unpatentable over Bears.

Claims 2-17 are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-17 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. Indeed, the Examiner acknowledges the shortcomings of Bear with respect to several of these claims (e.g., claims 2-4, 7, 10, 13, and 15). Accordingly, it is respectfully submitted that Bears fails to

claim, disclose, or even suggest the claimed invention, and thus the claimed invention is not unpatentable over Bears.

Regarding claim 31, the Examiner asserts that the claimed invention would have been obvious in view of Bears. However, it is respectfully submitted that Bears fails to claim, disclose, or even suggest optically switching and aggregating a received signal, as presently claimed. Indeed, Bears explicitly discloses an electrical based multiplexer/demultiplexer (e.g., 60) and electrical/optical converters (e.g., 54, 58) in the disclosed fiber service terminals (FST), thereby precluding the use of any optical switching means. Accordingly, it is respectfully submitted that Bears fails to claim, disclose, or even suggest the claimed invention, and thus the claimed invention is not unpatentable over Bears.

Claims 33-36 are dependent upon independent claim 31. Thus, since independent claim 31 should be allowable as discussed above, claims 33-36 should also be allowable at least by virtue of their dependency on independent claim 31. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. Indeed, the Examiner acknowledges the shortcomings of Bear with respect to several of these claims (e.g., claim 34). Accordingly, it is respectfully

submitted that Bears fails to claim, disclose, or even suggest the claimed invention, and thus the claimed invention is not unpatentable over Bears.

At this point it should be noted that the Bears reference is assigned to Nortel Networks Limited as evidenced by the assignment recorded on August 30, 2000, at Real/Frame 011195/0706. It should also be noted that the present application is assigned to Nortel Networks Limited as evidenced by the assignment recorded on August 14, 2001, at Real/Frame 012076/0337. It should further be noted that both the Bears reference and the present application were, at the time the claimed invention was made, either assigned to Nortel Networks Limited or subject to an obligation of assignment to Nortel Networks Limited. Accordingly, under 35 U.S.C. § 103(c), the Bears reference may not be a proper prior art reference for use against the claims of the present application.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-17, 31, and 33-36 be withdrawn.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 18-30 AND 32

On pages 2-9 of the Office Action, claims 18-30 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Bears (U.S. Patent No. 5,349,457) in view of Kimbrough et al. (U.S. Patent No. 6,362,908). This rejection is hereby respectfully traversed.

Regarding claim 18 (and 32?), the Examiner asserts that the claimed invention would have been obvious in view of Bears and Kimbrough et al. However, it is respectfully submitted that Bears and Kimbrough et al., either alone or in combination, fail to claim, disclose, or even suggest a modular switch comprising dual optical trunking modules, dual optical switch fabric modules, and a plurality of subscriber service modules, wherein the dual optical trunking modules are coupled to at least one of the dual optical switch fabric modules and the dual optical switch fabric modules are coupled to the subscriber service modules, as presently claimed. Indeed, Bears explicitly discloses an electrical-based multiplexer/demultiplexer (e.g., 60) and electrical/optical converters (e.g., 54, 58) in the disclosed fiber service terminals (FST), thereby precluding the use of any optical switching means. Kimbrough et al. also explicitly discloses any electrical-based switching means. Accordingly, it is respectfully submitted that Bears and Kimbrough et al., either alone or in combination, fail to claim, disclose, or even suggest the claimed invention, and thus the

claimed invention is not unpatentable over Bears in view of Kimbrough et al.

Claims 19-30 are dependent upon independent claim 18. Thus, since independent claim 18 should be allowable as discussed above, claims 19-30 should also be allowable at least by virtue of their dependency on independent claim 18. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. Indeed, the Examiner acknowledges the shortcomings of Bear with respect to several of these claims (e.g., claims 20, 21, 24, and 27). Accordingly, it is respectfully submitted that Bears and Kimbrough et al., either alone or in combination, fail to claim, disclose, or even suggest the claimed invention, and thus the claimed invention is not unpatentable over Bears in view of Kimbrough et al.

At this point it should be noted that the Bears reference is assigned to Nortel Networks Limited as evidenced by the assignment recorded on August 30, 2000, at Real/Frame 011195/0706. It should also be noted that the present application is assigned to Nortel Networks Limited as evidenced by the assignment recorded on August 14, 2001, at Real/Frame 012076/0337. It should further be noted that both the Bears reference and the present application were, at the time the

claimed invention was made, either assigned to Nortel Networks Limited or subject to an obligation of assignment to Nortel Networks Limited. Accordingly, under 35 U.S.C. § 103(c), the Bears reference may not be a proper prior art reference for use against the claims of the present application.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 18-30 and 32 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to

Patent Application
Attorney Docket No.: 57883.000039
Client Reference No.: 13766ROUS02U

Deposit Account No. 50-0206, and please credit any excess fees
to the same deposit account.

Respectfully submitted,

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